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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,107	02/20/2004	Masufumi Shimodaira	KIN98USA	7687

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EXAMINER	
COLE, ELIZABETH M	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/783,107.	SHIMODAIRA ET AL.	
	Examiner	Art Unit	
	Elizabeth M. Cole	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press felt as set forth in the preceding paragraph. Watanabe discloses a press having excellent rewetting suppression comprising a base layer, batt layers and a rewetting prevention layer. The layers are bonded by needling. See paragraph 0028. the rewetting prevention layer comprises a thin film. See paragraph 003. The film is perforated by needling punching. The perforation process produces holes having a three dimensional structure wherein the perforations have a funnel shape. See paragraphs 0034, 0045, 0048, and 0053, as well as figure 3. the layer can also have planar openings in addition to the three-dimensional openings. See claim 2. Watanabe teaches the use of nylon films as the rewetting prevention layer. See paragraph 0035. With regard to the limitation that the rewetting prevention layer is non-oriented, it is noted that while Watanabe teaches that biaxially oriented films are "suitable" for use, Watanabe also generically teaches the use of films as the rewetting prevention layer. Further, Watanabe teaches that using a biaxially oriented film prevents splitting of the of the film during the needling process, and therefore Watanabe implicitly teaches that

using unoriented films is less preferred, but known. See paragraph 0049. Finally, it is noted that Watanabe's claims are not limited to an oriented film.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2-3 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press felt as set forth above. Watanabe does not disclose the claimed elongation at break, however, since Watanabe discloses the same structure and the same materials, presumably the film of Watanabe would inherently have the claimed elongation at break.

5. Claims 1-2, 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eklund, U.S. Patent No. 4,446,187 in view of WO 03/029558. Eklund discloses a press felt comprising a reinforcement layer 3 which comprises a woven fabric having a nonwoven batt needled thereto and a foil layer formed from a thermoplastic film, (see col. 4, lines 30-51). The film has a plurality of holes or channels. See col. 4, lines 52-64. The channels can have a funnel shape. See figures 5-8. With regard to the limitation that the film is non-oriented, Eklund is silent as to whether the film is oriented

and therefore it is assumed that either it is not oriented or that the disclosure of Eklund encompasses both oriented and non-oriented films.

6. Eklund differs from the claimed invention because Eklund does not disclose that the re-wetting prevention layer is disposed within the batt layer. WO '558 teaches that re-wetting prevention layers should be disposed within batt layers in order to isolate the layer from the paper making surface so that it does not interfere with the paper forming process. See page 7, lines 10-20. WO '558 teaches that suitable materials for the anti-rewetting layer include apertured polymeric films. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have situated the anti rewetting layer of Eklund within the batt in order to avoid having the film layer interfere with the paper making process as taught by WO '558. With regard to claims 7-8, Eklund differs from the claimed invention because Eklund does not specifically disclose flat openings in addition to the three dimensional openings. However, Eklund teaches that the openings can have any configuration. See col. 3, lines 39-56. Therefore, it would have been obvious to one of ordinary skill in the art to have selected the shape and depth of the openings through the process of routine experimentation as taught by Eklund in order to form a press felt having the optimum rewetting prevention characteristics.

7. With regard to claims 5-6, Eklund differs from the claimed invention because Eklund does not specifically disclose flat openings in addition to the three dimensional openings. However, Eklund teaches that the openings can have any configuration. See col. 3, lines 39-56. Therefore, it would have been obvious to one of ordinary skill in

the art to have selected the shape and depth of the openings through the process of routine experimentation as taught by Eklund in order to form a press felt having the optimum rewetting prevention characteristics.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eklund in view of WO '558 as applied to claims 1-2, 5-8 above, and further in view of Gulya et al, U.S. patent No. 5,071,697. Eklund differs from the claimed invention because Eklund does not teach employing a nylon layer as the rewetting prevention layer. Gulya teaches at col. 2 lines 56-61, that nylon films are equivalent to the polyurethane films employed in Eklund for the purpose of forming a rewetting prevention layer in a press felt. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a nylon layer instead of a polyurethane layer as the rewetting prevention layer of Eklund, motivated by the teaching of Gulya that the two types of films were recognized as equivalents in the art. With regard to the claimed elongation at break, either the nylon layer of Gulya would inherently possess the claimed elongation at break, or else it would have been obvious to have selected the film composition, thickness, etc., so that it had the desired strength.

9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel, U.S. Patent No. 6,159,880 in view of WO '558. Schiel discloses a pres felt comprising a batt layer 2, a support layer comprising warp and weft threads 3 and 4 and an intermediate layer 12 which may be a film layer. See figures 1 and 4. Schiel does not disclose that the film is oriented and therefore it is reasonable to presume that it is unoriented. The layers can be needled together. The needling would necessarily

perforate the film and the perforations would necessarily have the claimed shape since they are formed in the same way as the perforations in the instant application. While Schiel appears to disclose the claimed structure, Schiel does not explicitly state that the intermediate layer is an anti-rewetting layer. WO '558 teaches incorporating an anti-rewetting layer within the press felt in order to prevent re wetting. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed an anti rewetting layer as the intermediate layer in Schiel, motivated by the expectation that this would prevent rewetting when the press felt of Schiel was used.

10. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel in view of WO '558 as applied to claims above, and further in view of Gulya et al, U.S. patent No. 5,071,697. WO '553 differs from the claimed invention because WO'553 does not teach employing a nylon layer as the rewetting prevention layer. Gulya teaches at col. 2 lines 56-61, that nylon films are suitable for use as the rewetting prevention layer in a press felt. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a nylon layer as the rewetting prevention layer of WO '553, motivated by the teaching of Gulya that this type of film was known in the art to be suitable for this purpose. With regard to the claimed elongation at break, either the nylon layer of Gulya would inherently possess the claimed elongation at break, or else it would have been obvious to have selected the film composition, thickness, etc., so that it had the desired strength.

11. Claims 13-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel in view of WO '558 as applied to claims above, and further in view of Eklund. Neither Schiel not WO '558 teach including both flat apertures and protuberances on the rewetting prevention layer. Eklund teaches that the openings can have any configuration. See col. 3, lines 39-56. Therefore, it would have been obvious to one of ordinary skill in the art to have selected the shape and depth of the openings through the process of routine experimentation as taught by Eklund in order to form a press felt having the optimum rewetting prevention characteristics.

12. Applicant's arguments filed 1/30/06 have been fully considered but they are not persuasive. Applicants arguments with regard to the objection to the specification are persuasive and therefore that objection is withdrawn.

13. With regard to Eklund, Applicant's arguments that Eklund does not teach the anti rewetting layer is within the batt layer have been considered but are moot in view of the new grounds of rejection.

14. With regard to the Watanabe reference, Applicant's certified translation is sufficient to remove the reference as a 102(a) reference. However, the reference remains as a 102(e) reference since the filing date of Watanabe is before the claimed priority date.

15. With regard the Watanabe reference, Applicant argues that Watanabe does not discloses an unoriented film. However, Watanabe discloses that biaxially oriented films are suitable for use and that the use of biaxially oriented films prevent splitting during the needling process. Therefore, unoriented films are implicitly disclosed in Watanabe,

but they are not preferred. However, since the Watanabe reference is a 102 reference the disclosure of an non preferred embodiment still anticipates the claimed invention. Also, since the claims of Watanabe do not specify that the films are biaxially oriented, or oriented at all, it is the examiner's position that Watanabe discloses films generally and that biaxially oriented films are the preferred embodiment, but that the claims of Watanabe also disclose unoriented films or uniaxially oriented films.

16. With regard to the exclusion of the Watanabe reference under 103(c), the Declaration states "on information and belief" as of October 1, 2001 that Watanabe application had been assigned to Ichikawa Co, Ltd. However, it is not clear what is meant by "information and belief". In order to invoke 103(c) a statement must be made to the effect that at the time the invention was made the application and reference were owned by or subject to an obligation of assignment to the same person. It is noted that this statement does not have to be in the form of a declaration and can be made by either applicant or applicant's representative. Since it is not fully clear from the declaration whether the application and reference were owned by or subject to an obligation of assignment to the same person at the time the invention was made the rejection is maintained for now. Once this is clarified the rejection would be withdrawn.

17. With regard to Eklund and Gulya, Applicant argues that Eklund does not teach a re wetting prevention layer. However, Eklund teaches employing the polymeric layer on top of the press felt as a liquid impermeable material which is then perforated so Eklund does teach the anti rewetting layer.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

Elizabeth M. Cole
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